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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,130	12/18/2001	Zhiming Zhou	56008US002	5126

32692 7590 10/06/2005

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EXAMINER
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MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/025,130

Applicant(s)

ZHOU ET AL.

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 30 to 32 and 39 to 56 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30 to 32, 39, 41 and 42 is/are allowed.
- 6) ☒ Claim(s) 43, 44 and 46 to 55 is/are rejected.
- 7) ☒ Claim(s) 40, 45 and 56 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
  - Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
  - Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some \* c) ☐ None of:
    - 1. ☐ Certified copies of the priority documents have been received.
    - 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. Claim 40 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 31. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

2. Claims 30 to 32, 39, 41 and 42 are allowed, for reasons of record.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 43, 44 and 46-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP380 236, herein Leir.

The teachings in Leir have been detailed in previous office actions. Applicants have added new claims which require that the backing have acid functional groups. This limitation was found in previous claims, such as claims 15 and 25 (cancelled). As noted previously, in view of the teachings in Leir indicating the general utility of the copolymers as coatings and adhesives, one skilled in the art would have readily recognized that acidic group containing surfaces could certainly be used as substrates. In fact, since the skilled artisan would recognize that the tertiary amine groups in Leir would be inherently attracted to acidic groups, the selection of such a surface would have been desirable to the skilled artisan. On the other hand, note that one of the substrates coated by Leir is a polyester (PET) film (example 33) which will inherently have at least some residual carboxylic acid groups. In this manner the selection of the particular surface would have been obvious over and/or is met by the teachings in Leir.

In addition to the acidic surface requirement, applicants have inserted language that the tertiary amine groups are "all in a form of a Lewis base" in an effort to exclude

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any ionized amine groups from being present in the copolymer. Such a limitation is met by the teachings in Leir. Pages 7 and 8 discuss the tertiary amine and the ionized form of the copolymer. This teaches ionization is necessary to achieve water compatibility or dispersibility. Lines 10 to 12 on page 8 specifically state that the copolymers can be used in their un-ionized form and coated from a solvent. This meets the requirement that all the tertiary amine groups be present in a Lewis base form. The silicone tackifying agent is found on page 9, lines 35 to 40.

Thus Leir anticipate the pressure sensitive adhesion composition required by claim 43 and the primer composition required by claim 50. As noted supra the selection of a substrate having acidic groups would have been obvious to the skilled artisan in view of the teachings of Leir. In this manner the instant claims are rendered obvious.


5. Claims 45 and 56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The teachings in Leir are not sufficient to render obvious the selection of these particular surfaces. While such surfaces are generally known, absent any motivation to select such surfaces from the myriad of surfaces available these claims are not obvious over the prior art.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
10/3/05